

**REMARKS:**

In the outstanding Office Action, the Examiner objected to claims 3-9, 17-20 and 23-25, rejected claims 1, 2, 10-16, 21, 22 and 26-33. Claim 32 is amended herein. No new matter is presented. Thus, claims 1-33 are pending and under consideration. The rejections are traversed below.

**ALLOWABLE SUBJECT MATTER:**

At item 7 of the outstanding Office Action, the Examiner indicated that claims 3-9, 17-20 and 23-25 would be allowable if rewritten in independent form to include features of any intervening claims.

The rejection of the independent claims, upon which claims 3-9, 17-20 and 23-25 depend, is traversed below.

Therefore, claims 3-9, 17-20 and 23-25 are allowable.

**REJECTIONS UNDER 35 U.S.C. § 102(b):**

Claims 1, 14 and 27-33 were rejected as being anticipated under 35 U.S.C. § 102(b) by JP 05-160979 (Sato).

Sato is directed to terminating a facsimile apparatus when an incoming call from another facsimile equipment has identification information that is assigned to have a higher priority. For example, a current communication link under processing is interrupted when an incoming call matches priority level of an identification information registered as having top priority (see, paragraphs 22 and 26). That is, Sato is limited to permitting receipt of data from a partner facsimile apparatus based on assignment of the highest priority level to identification information of the facsimile apparatus.

In contrast to Sato, as recited in independent claims 1 and 14, the present invention determines "whether a second party previously determined to be capable of urgently receiving the data" is demanding an urgent transmission of data based on "a phone number of the second party." An on-going communication is interrupted "upon determining that the urgent transmission of data is required from the second party during communication with the first party" (see, claims 1 and 14).

Similarly, claim 32 as amended recites, "checking whether an urgent transmission of data is required from a second party previously determined to urgently receive the data during

communication with a first party based on a phone number of the second party”, “outputting the checked result as a first control signal” and “interrupting communication with the first party in response to the first control signal to receive the data from the second party.”

Sato does not teach or suggest interrupting an on-going communication in accordance with determination of whether “urgent transmission is required from a second party” who is “previously determined to be capable of urgently receiving the data based on a phone number of the second party”, as recited in claims 1, 14 and 32. Instead, Sato is limited to permitting receipt of data from facsimile apparatuses assigned to have a higher priority level.

It is submitted that the independent claims are patentable over Sato.

For at least the above-mentioned reasons, claims depending from the independent claims are patentably distinguishable over Sato. The dependent claims are also independently patentable. For example, claim 33 recites, “determining whether the phone number of the second party is a predetermined urgent phone number.” Sato does not teach or suggest a method to urgently receive data via facsimile including, “determining whether the phone number of the second party is a predetermined urgent phone number”, as recited in claim 33.

Therefore, withdrawal of the rejection is respectfully requested.

#### **REJECTION UNDER 35 U.S.C. §103(a):**

Claims 2, 10-13, 15, 16, 21, 22 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of the following: Sato, JP 07-236007 (Naka) and JP 03-278641 (Fukuda).

At item 3 of the outstanding Office Action, the Examiner states that a facsimile device capable of making telephone calls is well known. Applicants respectfully traverse the Examiner’s statement and demand the Examiner to produce authority for the statement. The Applicants specifically point out the following errors in the Examiner’s action.

First, the Examiner uses common knowledge (“well-known”) evidence for the rejection. As explained in the M.P.E.P.,

any facts so noticed should... server only to “fill in the gaps” in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection. It is never appropriate to rely solely on

common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection is based. M.P.E.P. § 2144.03

Second, the noticed fact is not considered to be common knowledge or well-known in the art. In this case, the limitation is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, this limitation is unique to the present invention (see, M.P.E.P. § 2144.03(A) (the notice of facts beyond the record which may be taken by the Examiner must be “capable of such instant and unquestionable demonstration as to defy dispute”).

Third, there is no evidence supporting the Examiner’s assertion (see, M.P.E.P. § 2144.03(B) (“there must be some form of evidence in the record to support an assertion of common knowledge”).

Fourth, the Examiner appears to be basing the rejections, at least in part, on personal knowledge. The Examiner is required under 37 C.F.R. § 1.104(d)(2) to support such assertion with an affidavit when called for by the Applicant. The Examiner is called upon to support such assertion.

Further, even if the Examiner’s assertion and rejection based on common knowledge is valid, the present invention is distinguishable as discussed below.

Naka is directed to selecting priority of an interruption call according to urgency or importance of a call. For example, a user sets urgency or importance using a prescribed key operation on a facsimile equipment and a line is released upon determination of the significance of the urgency based on frequency of a message demand from the user, etc. (see, Abstract and paragraphs 9, 11 and 15). That is, Naka is limited to setting importance identification information by a user and determining priority for an interruption call based on data related to interruption call demands from the user.

Fukuda establishes an interrupt when a sender designates a priority mode so that facsimile information with a high priority is received prior to the other facsimile information (see, Abstract and FIG. 1). That is, Fukuda is limited to categorizing facsimile information to transmit facsimile information designated as priority by a sender is first.

In contrast, the present invention is directed to urgently receiving data via facsimile based on determination that urgent transmission of data is required from a “second party during communication with the first party”, where the second party is “previously determined to be

capable of urgently receiving the data" (see independent claims 1 and 14 from which claims 2, 10-13, 15, 16, 21, 22 and 26 depend).

For at least the above-mentioned reasons with respect to independent claims 1 and 14, dependent claims 2, 10-13, 15, 16, 21, 22 and 26 are also patentably distinguishable over the cited references.

The dependent claims are also independently patentable. For example, dependent claims 2 and 15 recite that the determination of whether an urgent transmission of data is demanded comprises determining whether "an urgent receipt function is enabled", storing "a phone number of the second party upon determining" and "interrupting communication held with the first party and receiving the urgent data from the second party, upon determining that the phone number of the second party is among the urgent numbers."

Dependent claim 21 also recites that "the condition detector checks whether the urgent receipt enable condition is satisfied in response to the third control signal", where the urgent receipt enable condition is "a case where the second party demands an urgent transmission of data while data is being transmitted to and/or received from the first party."

Therefore, withdrawal of the rejection is respectfully requested.

#### CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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